

Application No. 09/972,887
Reply to Office Action of June 5, 2003



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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
YOSHINAO NAGASHIMA, ET AL. : EXAMINER: TRAVERS, RUSSELL S
SERIAL NO: 09/972,887 :
FILED: OCTOBER 10, 2001 : GROUP ART UNIT: 1614
FOR: AUTONOMIC NERVE :
REGULATING AGENT :

RESPONSE TO REQUIREMENT FOR RESTRICTION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Official Action of June 5, 2003, Applicants elect, with traverse, Group I, Claims 1-14, drawn to a method of regulating the autonomic nervous system by administering various natural product alcohols.

REMARKS

The Office has required restriction in the present application as follows:

- Group I: Claims 1-14, drawn to a method of regulating the autonomic nervous system by administering various natural product alcohols;
- Group II: Claims 15-19, drawn to various natural product alcohol compositions; and
- Group III: Claims 20, drawn to a vaporization system consisting of a physical element providing energy to produce heat sufficient for vaporizing compounds.

Restriction is only proper if the claims of the restricted groups are either independent or patentably distinct. The burden of proof is on the Office to provide reasons and/or examples to support any conclusion with regard to patentable distinctness. MPEP §803.

Applicants respectfully traverse the requirement for restriction on the grounds that the Office has not provided adequate reasons and/or examples to support a conclusion of patentable distinctness between the identified groups.

The Office, citing PCT Rules 13.1 and 13.2, contends that the Groups I-III, lack unity.

MPEP 1893.03 (d) states:

When making a lack of unity of invention requirement, the Examiner **must...** (2) explain why each group lacks unity with each other group (i.e., why there is no single general inventive concept) specifically describing the unique special technical feature in each group.

Applicants note that the Office has merely stated a conclusion absent any explanation whatsoever as to why the subject matter within the groups lack unity. Accordingly, Applicants submit the Requirement for Restriction is not sustainable and should be withdrawn.

Further, Applicants wish to point out that MPEP § 1893.03(d) states that:

A group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature.

Whilst making no claims to patentability, Applicants, note that Groups I-III share a common special technical feature a “sequiterpene alcohol” as set forth in Claim 1.

Accordingly, the criteria for unity of invention are satisfied. Therefore the Requirement for Restriction is not sustainable and should be withdrawn.

In addition, Applicants wish to point out that MPEP § 1893.03(d) states that:

An apparatus or means is “specially designed” for carrying out the process when the apparatus or means is suitable for carrying out the process with the technical relationship is being present between the claimed apparatus or means and the claimed process.

Whilst making no claims to patentability, Applicants note that the process of Group I can be practiced in the apparatus of Groups III. Accordingly, the criteria for unity of invention are satisfied and the Restriction Requirement is not sustainable and should be withdrawn.

Applicants respectfully submit that a search of all the claims would not impose a serious burden on the Office. MPEP in §803.

Accordingly, and for the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the Requirement for Restriction. Withdrawal of the Requirement for Restriction is respectfully requested.

Claims 1-20 are pending. Favorable consideration is respectfully requested.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully submitted,

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